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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Zeev Maor

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12/10/2009

THE NATH LAW GROUP

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Alexandria, VA 22314

EXAMINER

FRAZIER, BARBARA S

ART UNIT

PAPER NUMBER

1611

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/519,387	Applicant(s) MAOR ET AL.	
	Examiner BARBARA FRAZIER	Art Unit 1611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5,6,8,11,12 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,6,8,11,12 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Status of Claims

1. Claims 1, 3, 5, 6, 8, 11, 12, and 18 are pending in this application.
2. Addition of new claim 18 is acknowledged.
3. Cancellation of claims 16 and 17 is acknowledged. Claims 2, 4, 7, 9, 10, and 13-15 stand canceled.
4. Claims 1, 3, 5, 6, 8, 11, 12, and 18 are examined.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. The previous rejection of claims 1, 3, 5, 6, 8, 11, 12, 16, and 17 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, specifically as it pertains to the phrase, "said demagnetized nanoparticles being present in a quantity greater than naturally found in Dead Sea mud", is withdrawn in view of Applicant's amendment to claim 1 deleting said phrase from the claim.

The following rejection is newly applied:

7. **Claims 1, 3, 5, 6, 8, 11, 12, and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter which was not described in the specification in such a

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way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1, as amended, now claims that the demagnetized nanoparticles dispersed therein are "present in an amount of 1 to 20 wt%" (lines 4-5 of claim 1). While Applicants assert that support for the amendment can be found throughout the specification and claims as originally filed, support for the demagnetized nanoparticles "present in an amount of 1 to 20 wt%" is not found in the specification and claims as originally filed. While Example 7 (page 8 of the specification) does teach 1 to 20% of magnetic hard compositions selected from magnetite (or Dead Sea bath salt, Dead Sea minerals, Dead Sea mud or a mixture thereof), it does not teach other demagnetized nanoparticles in said amounts. Therefore, the compositions wherein the demagnetized nanoparticles other than magnetite are present in an amount of 1 to 20 wt% constitute new matter.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. The previous rejection of claims 1, 3, 5, 6, 8, 11, 12, 16, and 17 under 35 U.S.C. 112, second paragraph is withdrawn in view of Applicant's amendment to claim 1 and cancellation of claims 16 and 17.

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The following rejection is newly applied:

10. Claims 1, 3, 5, 6, 8, 11, 12, and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, as amended, now recites, “[A] cosmetic preparation for topical application onto skin of a subject, the preparation **consisting of**” (lines 1 and 2 of claim 1), and “**optionally one or more** cosmetically acceptable additives” (line 7 of claim 1). The transitional phrase “consisting of” excludes any element, step, or ingredient not specified in the claim, and is defined as “closing the claim to the inclusion of materials other than those recited except for impurities ordinarily associated therewith”. See MPEP 2111.03. Since the claim includes closed language “consisting of”, but also includes the open language of “optionally one **or more**” (which can include an unlimited number of additives), the metes and bounds of the claim are unclear, rendering the claim indefinite.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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12. Claims 1, 3, 5, 6, 8, 11, 12, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maor (WO 00/40255) in view of Zastrow et al (US Patent 5,961,988, hereinafter “Zastrow ‘988”), and further in view of Shiga Yoko (JP 4,108,710, abstract submitted herewith).

The claimed invention is drawn to a cosmetic preparation for topical application onto skin of a subject, the preparation consisting of Dead Sea mud and demagnetized nanoparticles dispersed therein and present in an amount of 1 to 20 wt%, the demagnetized nanoparticles being suitable for magnetization when applied to the skin of the subject; and optionally one or more cosmetically acceptable additives (see claim 1).

Maor et al teach a pharmaceutical cream composition for topical application for the treatment of skin disorders and skin diseases, comprising Dead Sea Mud as an active ingredient (abstract), which contains Dead Sea minerals (pages 4 and 5) as evidenced by Applicant's specification (see page 6 of Applicant's disclosure).

Maor et al do not teach the presence of demagnetized nanoparticles.

Zastrow '988 teach a dermatological preparation containing magnetically hard particles such as strontium hexaferrite, and asymmetrical lamellar aggregates loaded with oxygen to the saturation limit, and cosmetic or dermatological excipients (col. 1, lines 37-59) which may be used in an emulsion/cream (for example, see col. 3, lines 23-24 and Example 1C). It is noted that said particles are the same as those exemplified by Applicants; see page 7, lines 1-7 and claims 16-17 of Applicant's disclosure. The magnetic particles have a particle size in the range of 80 to 550 nm (col. 1, lines 41-42),

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and thus are "nanoparticles". The magnetic particles have a high wound healing effect and anti-inflammatory effect (col. 1, lines 22-23) and are useful for hypersensitive skin (Example 2). The asymmetrical lamellar aggregates are added to the cosmetic composition and thus are cosmetically acceptable, and therefore reasonably read on the phrase, "cosmetically acceptable additive".

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to combine the magnetic particle/lamellar aggregates taught by Zastrow '988 with the Dead Sea mud cream taught by Maor et al; thus arriving at the claimed invention. One skilled in the art would have been motivated to add the magnetic particle/lamellar aggregates taught by Zastrow '988 to the Dead Sea mud cream taught by Maor et al, because the addition of the magnetic particle/lamellar aggregates provides the benefits of high wound healing effect and anti-inflammatory effect, as well as treatment of hypersensitive skin, as taught by Zastrow '988 (e.g., see col. 1, lines 22-31). One would reasonably expect success from the combination of the of the Dead Sea mud cream taught by Maor et al with the magnetic particles taught by Zastrow '988, because both references are drawn to cosmetic compositions in the form of emulsion/creams for the treatment of skin disorders.

Regarding the limitation that the nanoparticles are demagnetized when dispersed in the preparation but suitable for magnetization when dispersed in the preparation or when applied to the skin, Zastrow '988 is silent with respect to when the nanoparticles are magnetized.

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Shiga Yoko teaches preparations for stimulating blood circulation comprising magnetic particles, such as ferromagnetic particles (abstract). Shiga Yoko further teach that, when ferromagnetic substances are dispersed in a cosmetic preparation in the demagnetized state and the preparation is magnetized after cosmetic application to the skin, this form of application is said to have a circulation-stimulating effect (see abstract).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to use demagnetized magnetic particles which are magnetized after cosmetic application to the skin in the composition of Maor and Zastrow '988; thus arriving at the claimed invention. One skilled in the art would be motivated to do so because the use of the magnetic particles of Zastrow '988 in the form as taught by Shiga Yoko results in the benefit of increased circulation to the skin, as taught by Shiga Yoko. One would reasonably success from the use of the magnetic particles of Zastrow '988 in the form taught by Shiga Yoko because both references are drawn to the use of ferromagnetic particles for cosmetic application to the skin.

Regarding the limitation that the demagnetized nanoparticles are present in an amount of 1 to 20 wt%, Zastrow '988 teach that the amount of particles is 0.001 to 50 wt% (col. 1, lines 62-63). The amounts of Zastrow '988 overlap with the amount range of the claimed invention; one skilled in the art would be able to manipulate the amounts magnetic particles from within said ranges by routine experimentation, in order to optimize the efficacy of the resultant composition.

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Regarding claims 3 and 18, Applicants have elected strontium hexaferrite as the elected species for the nanomagnetic particles. Zastrow '988 teach strontium hexaferrite as the magnetic particles (col. 1, lines 37-39).

Regarding the form of the composition (claims 5 and 6), Maor et al teach that the compositions are cream /emulsion compositions including milk, lotion, cream, and ointment (page 2). Zastrow '988 teach that the compositions are in emulsion, cream, and ointment form (see Examples 1, 2, and 4).

Regarding claim 8, Zastrow '988 teach that the lamellar aggregates loaded with oxygen yield a greatly improved anti-inflammatory effect (col. 4, lines 38-42), and therefore said aggregates reasonably read on a "medically active agent" (lines 3-4 of claim 8). Additionally, Maor et al teach that odorants such as fragrance may be present (Table 1, page 6), and Zastrow '988 teach that cosmetic active ingredients, such as vitamins, may be present (col. 3, lines 13-16).

Regarding claims 11 and 12, Zastrow '988 teach that the magnetic particles have a particle size in the range of 80 to 550 nm. This would, therefore, classify them as "nanoparticles". Furthermore, the size range cited in Zastrow '988 overlaps with the size range described in claims 11 and 12 of the claimed invention, and one skilled in the art would have be motivated to select an optimal size for the magnetic particles from within said ranges by routine experimentation, in order to optimize the wound healing and anti-inflammatory properties of the magnetic particles.

Response to Arguments

13. Applicant's arguments filed 8/10/09 have been fully considered but they are not persuasive.

Applicants argue that the presently claimed subject matter cannot include lamellar aggregates present in any amount (as required by Zastrow) because independent claim 1 has been amended to recite the closed ended transition language "consisting of", and Applicants submit that lamellar aggregates are not present in the claimed subject matter. Applicants also argue that there is no motivation to modify the cited references to achieve the presently claimed subject matter as so doing would destroy the principle operation of Zastrow et al and the proposed modification would render Zastrow et al unsatisfactory for its intended purpose.

This argument is not persuasive because the lamellar aggregates of Zastrow reasonably read on "cosmetically acceptable additives", since they are added to the cosmetic composition of Zastrow, and thus are cosmetically acceptable. Therefore, the cited references do not need to be modified, and thus Zastrow is not rendered unsatisfactory for its intended purpose. Additionally, the recitation of "and optionally one or more cosmetically acceptable additives" does not limit the preparation to consisting of only Dead sea mud and the demagnetized nanoparticles, as discussed above in the rejection under 35 U.S.C. 112, second paragraph (see paragraph 10).

Therefore, it is the Examiner's position that the claims are rendered obvious.

Conclusion

No claims are allowed at this time.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BARBARA FRAZIER whose telephone number is (571)270-3496. The examiner can normally be reached on Monday-Thursday 9am-4pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau can be reached on (571)272-0614. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BSF

/Ashwin Mehta/
Primary Examiner, Technology Center 1600